

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Application Number : 10/058,175 Confirmation No.: 3199
Applicant : Joshua Gee-Yuen MAHOWALD et al.
Filed : January 29, 2002
Title : SYSTEM AND METHOD FOR INTERACTIVE VOICE
SERVICES USING MARKUP LANGUAGE WITH N-BEST
FILTER ELEMENT
TC/Art Unit : 2655
Examiner: : B. Albertalli
Docket No. : 53470.009005
Customer No. : 21967

Mail Stop: AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

REQUEST FOR PRE-APPEAL BRIEF CONFERENCE

Pursuant to the Pre-Appeal Brief Conference Pilot Program announced in the Official Gazette, Applicants hereby request a pre-appeal brief conference in the above-referenced case. No amendments are being filed with this request. Additionally, this request is being filed with a Notice of Appeal.

This application is appropriate for a pre-appeal brief conference. A brief history of this application and why applicants believe that an appeal will succeed are set forth below.

This application was filed almost five years ago on January 29, 2002. On February 2, 2005, an initial action was issued rejecting claims 1-18 based on the proposed combination of two references – Motorola VoxML 1.1 Language Reference (“Motorola”) and U.S. Patent No. 6,449,496 to Beith et al. (“Beith”) – under section 103. Applicants timely filed a response to the Office Action and argued against the rejection for lack of motivation to combine. On August 19,

2005, claims 1-18 were rejected once again using the same two references under section 103. Applicants timely filed a Notice of Appeal and a Request for Pre-Appeal Brief Conference on December 15, 2005. On January 30, 2006, the Office found Applicants arguments persuasive and reopened prosecution. On March 31, 2006, a new Office Action was issued rejecting claims 1-18 yet again with the same Motorola and Beith references under section 103. In addition, the Office Action provided a new rejection of claims 1-12 under section 101 for non-statutory subject matter. Despite another attempt by Applicants to clarify important distinctions of the present invention – this time also amending the claims, as suggested by the Office, to direct the claims to patentable subject matter, a final rejection was filed on October 19, 2006. Rather than withdrawing the rejections and allowing the claims, the final Office Action maintained the same rejections under sections 101 and 103 and issued a new rejection of claims 1 and 7 for allegedly failing to comply with the written description under section 112, first paragraph, and a new rejection of claims 1-7 for allegedly being indefinite under section 112, second paragraph.

Initially, with respect to the Office's rejections under section 101, Applicants have previously amended claim 1 to specify a "computer-readable storage medium comprising code programmed in a markup language" and claim 7 to specify an "active voice page in a computer-readable storage medium." While the Office Action suggests using "encoded" rather than "comprising," Applicants respectfully submit that the claims are adequately directed to patentable subject matter in their present form. As a result, the rejection of claims 1-12 is improper and should be withdrawn.

With respect to the Office's new rejections under section 112, first and second paragraphs, the Office alleges that there is "no clear support" or "clear disclosure" for the

amendments previously made to claim 1 and 7 (even though the Office itself had suggested these changes). Applicants respectfully disagree.

“In order to satisfy the written description requirement, the disclosure as originally filed does not have to provide *in haec verba* support for the claimed subject matter at issue.” Purdue Pharma L.P. v. Faulding, Inc., 230 F.3d 1320, 1323, 56 USPQ2d 1481, 1483 (Fed. Cir. 2000). In other words, as stated in MPEP § 2163.02, the fundamental factual inquiry is whether a claim defines an invention that is clearly conveyed to those skilled in the art at the time the application was filed. The subject matter of the claim need not be described literally (i.e., using the same terms or *in haec verba*) in order for the disclosure to satisfy the description requirement. In this case, one skilled in the art at the time of the application was filed would clearly understand that a markup language for facilitating voice-enabled communication may be used in a tangible “computer-readable storage medium.” Furthermore, the specification clearly recites that markup language can be “adapted to enable systems to communicate” (page 2), where such systems include various types of computer servers, such as call servers, web servers, voice service servers, remote servers, etc. Therefore, the rejections of claims under section 112, first and second paragraphs are improper and should be withdrawn.

With regard to the Office’s rejection under section 103, the Office continues to misapply its obligation to provide motivation to combine references despite Applicants clearly indicating its deficiencies. Specifically, the Office Action fails to set forth a proper *prima facie* case of obviousness.

First, while the Office recognizes that the Motorola reference does not disclose or suggest an n-best list filter element in an XML-based language structure as recited in the claims, it presumes that Beith remedies this deficiency because it alleges “a method for requesting

verification from a list of possible matches for an audibly-uttered user response”. *See* Office Action at p. 6. However, Applicants respectfully submit that **Beith does not disclose, suggest, or even contemplate “an n-best list filter element”**. The mere disclosure of a method for requesting verification from a list is not the same as an n-best list filter element recited in the claims. Accordingly, Applicants respectfully submit that not all of the claimed limitations are taught in the references.

Second, the PTO asserts that modifying the Motorola reference to include the n-best list filter feature would have been obvious “because such feedback greatly improves the accuracy and increases the user confidence in the system.” *See* Office Action at p. 6. However, such a statement represents classic **impermissible hindsight**. The Office Action fails to provide any *evidence* as to why one of ordinary skill in the art would choose to implement the n-best list element in the way claimed. Instead, the Examiner relies on his own hindsight conjecture. Apparently, the Office Action’s statement that it would greatly improve accuracy and increase user confidence in the system is wholly unsupported by Motorola or Beith. Although the Office attempts to use the Balentine reference as a source of motivation to combine Motorola and Beith, the reference was clearly “not relied upon” by the Office. As a result, none of the references specifically cited in the Office’s rejection states anywhere that there is an advantage in adding an element in the XML-based language.

The Office Action’s modification of Motorola and Beith in view of the other cited references – AAPA and Ladd – suffers from similar flaws. For example, in claims 6 and 12, the Office acknowledges that neither Motorola nor Beith discloses “an error announcement is made when a match is not found.” *See* Office Action on p. 7. The PTO asserts that AAPA remedies this deficiency because it is supposedly “notoriously well known...to provide the user with an

announcement that no match has been found, such as "I did not understand" or requesting the user to repeat the utterance". See Office Action at p. 7. However, AAPA does not disclose the recitation as alleged by the Office nor does the AAPA support this conclusion as a whole. Rather, Applicants respectfully submit that the PTO gleaned from Applicant's Detailed Description on page 2, the only section that recites "I did not understand," to improperly construct the motivation. Thus, absent further evidence, the Office has clearly failed to meet its *prima facie* burden.

Thus, an appeal on that basis will certainly succeed, but the time and expense in preparing an appeal brief on that issue should not be borne by MicroStrategy when the grounds is so clearly improper.

Respectfully submitted,



Brian M. Buroker
Registration No. 39,125

Hunton & Williams LLP
1900 K Street, NW
Washington, D.C. 20006-1109
(202) 955-1500

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